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09/385,405	08/30/1999	WILLIAM J. SCHMIDT	671.1.002CIP	9104

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PRINCETON JUNCTION, NJ 08550

EXAMINER

POPOVICS, ROBERT J

ART UNIT PAPER NUMBER

1724

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20040504

Application Number: 09/385,405  
Filing Date: August 30, 1999  
Appellant(s): SCHMIDT, WILLIAM J.

\_\_\_\_\_  
Allen Kipness  
For Appellant

**MAILED**  
APR 29 2005  
**GROUP 1700**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 14, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is **incorrect**.

Under this section, Appellant asserts:

***"The starting waste gelatin material is required to contain at least one component which cannot effectively be separated from the gelatin-containing liquid into a non-solvent based layer as discussed below.***

***Thus, the waste material is required to have at least one component which remains with a solvent based layer because it cannot be separated into a non-solvent based layer."***

Appellant continues:

***"Support for the waste material containing at least one first component which cannot be effectively separated from the first liquid into a non-solvent based layer is described in the specification at page 9, lines 3-7 wherein the definition of the solvent based layer states that the components therein dissolve in the solvent and therefore may be separated from the non-solvent based layer which includes components that do not dissolve in the solvent."***

(Emphasis added by Appellant)

From page 8, line 18 -page 9, line 7 of the instant specification:

A solution of gelatin and glycerin [i.e. solvent based layer (e.g. aqueous layer)] is thus formed within the remaining oily component and residual active-ingredient components [i.e. non-solvent based layer (e.g. non-aqueous layer)]. As used herein the term "solvent based layer" shall mean a layer or phase in which the components contained therein are dissolved in the solvent. The term "non-solvent based layer" shall mean a layer or phase in which the components therein do not dissolve in the solvent and therefore may be separated from the solvent based layer. Since water is the preferred solvent reference will be made hereinafter to the aqueous layer and nonaqueous layer.

(underscored text corresponds to the section referenced by Appellant as supporting the summary of the invention, i.e., Page 9, lines 3-7)

The above excerpts taken from Appellant's Brief are unsupported by the originally filed disclosure. The basis for **"the requirement"** asserted above is not found in the section of the specification where it is asserted to be – i.e., **"specification**

***at page 9, lines 3-7."*** The originally filed disclosure does not provide support for a ***"requirement"*** that ***"The starting waste gelatin material is required to contain at least one component which cannot effectively be separated from the gelatin-containing liquid into a non-solvent based layer."*** There simply is no such ***"requirement."***

Indeed, it is tough to nail down an accurate summary of Appellant's invention, as it appears to be a continually moving target, asserted to be "in situ" processing (see originally filed specification – "Background" section), the ability to address waste materials on a commercially acceptable scale in one instance (see the Declaration of Appellant Schmidt), while at the same time being asserted to be the ability to address contaminants that cannot be effectively separated, with both of these later assertions constituting apparent afterthoughts, as they find no support, basis, or suggestion in the originally filed disclosure. Perhaps, it is best to rely on the "Summary of the Invention" as it appears in Appellant's originally filed specification:

#### SUMMARY OF THE INVENTION

The present invention is generally directed to the recovery of waste gelatin alone or in combination with other components of a waste gelatin product through the separation and treatment of a waste gelatin stream into an aqueous and non-aqueous substream.

In one aspect of the present invention there is provided a method of treating a waste material containing gelatin comprising:

a) combining the waste material and a solvent for the gelatin to form a liquid containing gelatin;

b) separating the liquid into a solvent based phase or layer and a non-solvent based phase or layer; and

c) removing residual oils and/or particulates from the solvent based layer to form a second liquid containing gelatin having a higher purity than the first liquid.

**(6) *Issues***

Appellant's statement of issues is **incorrect**. Appellant states that claims **74** and **82** are rejected under 35 U.S.C. 102(b). They are not. Appellant has been, at least thrice notified that the Statement of Issues was incorrect. Appellant was first notified via the Notice of Defective Brief mailed on May 17, 2004. Subsequent to that, Appellant was explicitly informed during the Interview of May 27, 2004 that the basis for the art rejection had changed from Section 102 to Section 103 with respect to claims **74** and **82**, as set forth at paragraphs 16 and 17 of the Final Rejection mailed August 13, 2002. Thereafter, Appellant was twice notified via comments on the notices of abandonment that the "Statement of Issues" was incorrect.

**(7) *Grouping of Claims***

The rejection of claims 71-83 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

U.S. Patent No. **5,288,408** to Schmidt et al. is the sole reference relied on.

U.S. Patent No. **6,361,802** to Schmidt is cited as of interest. Admissions made by Applicant during the prosecution of Patent No. **6,361,802** are noted below.

Publication No. **US 2002/0070165** is the pre-grant publication of the instant application.

U.S. Patent No. **6,726,841** to Schmidt is cited as of interest.

**(10) Grounds of Rejection**

Claims **71-83** are rejected under 35 U.S.C. 112 (First), 102(b) & 103. These rejections are set forth in prior Office Action, Paper No. 35, and incorporated herein as if set forth in full. **All rejections under 35 U.S.C. 112 (Second) have been withdrawn.**

**(11) Response to Argument**

Before getting into the specific arguments, the Examiner notes that US Patent No. 6,361,802 issued to Mr. William J. Schmidt, on March 26, 2002. This is the same William J. Schmidt now identified as the instant Appellant. Pages 4-7 of the Remarks of the Amendment filed September 19, 2001 in that case, serial number 09/609,217, were previously made of record and incorporated by reference as if set forth in full. These Remarks were previously cited on a PTO-892. The Remarks made in that document beginning at page 5, line 12 through page 6, line 22 are especially illuminating. The

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admissions made by Appellant during the prosecution of 09/609,217 are in complete contradiction with the arguments now being presented regarding Applicant's own prior patent – U.S. Patent No. 5,288,408, which was applied as a reference in both the instant application and 09/609,217.

Compare the argument made at page 16, lines 1-4, of the instant Brief:

“What is important is that Applicant's invention is directed to the treatment of the solvent based layer, not to the treatment of the non-solvent based layer which is the subject of the invention described in the sole prior art reference [i.e. Schmidt 5,288,408] cited against the present claims.”

with the argument made beginning at page 5, line 12 of the above mentioned

Remarks in 09/609,217 (emphasis added by Examiner):

“The process described in Schmidt et al. (U.S. Patent No. 5,288,408) clearly focuses on the recovery and purification of gelatin and softening agents (e.g. glycerin). As indicated in Figure 1 and beginning with the text at column 3, line 40 the gelatin waste material (which includes fills) is combined with a solvent (e.g. deionized water) and allowed to stand (column 3, line 64-67). A lower solvent phase is separated from an upper oil (non-solvent) phase and then the lower solvent phase is further treated which is the clear focus of the '408 Patent reference. Referring to Figure 1, the solvent phase (e.g. aqueous phase) is then sent to a hot filtration process and to vacuum distillation where eventually purified gelatin and glycerin are obtained. Thus, the '408 Patent reference is principally concerned with the solvent phase and its treatment to obtain purified gelatin and softening agent (e.g. glycerin).”

It is incomprehensible how Appellant can make such inconsistent statements regarding his own prior patent.



The rejections made under the second paragraph of 35 USC 112 (Second Paragraph) have been withdrawn.

Regarding the new matter rejection of claim 71 under the First Paragraph of 35 USC 112, Appellant has argued: ***"this language was incorporated into claim 71 to emphasize the material distinctions between the claimed invention and the Schmidt et al. prior art reference which concerned the treatment of the non-solvent based layer."*** The Examiner finds no material distinctions. Moreover, the added language is unsupported by the originally filed specification. It is respectfully submitted that the time to add language emphasizing ***"material distinctions"*** is at filing, and not well into the prosecution. Finding no support in the originally filed disclosure, this added language constitutes prohibited new matter. Finally, Appellant mischaracterizes the "Schmidt et al. prior art reference," as evidenced by his admissions as discussed above. In any event, if the Board finds that there is support for this language in the originally filed specification, then the same degree of latitude must be afforded to the "Schmidt et al. prior art reference," since Applicant cannot point out any discernable difference between the "Schmidt et al. prior art reference" and his **originally** filed disclosure. The same applies to the rejection of claim 72 under 112 First Paragraph. The Brief points out that ***"Page 13, lines 11-13 of the specification states that the separated solvent based layer (e.g. aqueous layer) contains particulates and/or oily type materials which are specific examples of the first component contaminants of interest in the present***

***invention and referred to in the present claims. These materials end up in the solvent based layer such as by being dissolved therein.***" Here, Appellant mischaracterizes the teachings of his specification. The sentence Appellant refers to begins with "***If***," yet Appellant's argument asserts that the specification teaches that they **are "required" to be present**. Again, should the Board find that there is support in the **originally** filed specification for the language in question, then the same degree of latitude must be given to the Schmidt reference, which discloses the presence of the same contaminants (i.e., oils, coloring agents, etc.). In other words, should the Board find basis in Appellant's original disclosure for the language in question, the same language should logically flow from the applied reference since the disclosures are so similar.

Assuming arguendo that Appellant's original disclosure does provide support for the language in question, the same waste materials/contaminants (i.e., oils, coloring agents, etc.) are disclosed in Schmidt '408. Nothing in the instant disclosure indicates that the make-up of conventional waste materials has changed. Therefore, the same contaminants that ***"cannot be effectively separated"*** would have been present and addressed by Schmidt '408, in order to obtain **"a recycled gelatin product with chemical and physical properties identical to virgin gelatin"** (Schmidt '408; col. 2, lines 48-51).

### **35 USC § 102 Arguments**

Appellant, in his Brief, at page 19, lines 4-7, asserts, ***"the method disclosed in Schmidt et al. U.S. Patent No. 5,288,408 and the present application are similar except that Schmidt et al. does not require a waste gelatin material which must have a first component as defined herein."*** In reality, there is no difference between Schmidt et al. '408 and Appellant's instant claimed invention. The starting materials are the same. The resultant mixtures will behave the same way.

### **35 USC § 103 Arguments**

With respect to the rejection of claims 72 and 84 under Section 103 in view of the combined teachings of Schmidt '408 and Dutre, Appellant makes only naked assertions and draws unsupported conclusions. For example, Appellant asserts, ***"However, ultrafiltration cannot be employed in step (c) of the claimed process to remove the first component from the solvent based layer to form a second liquid containing gelatin having a higher purity than the first liquid being at least substantially devoid of the first component."*** - Why not???

Appellant concludes, ***"The substitution of an ultrafiltration technique of the secondary reference in the waste gelatin process of Schmidt et al. does not result in a method of treating a waste gelatin material that is capable of removing residual oils and/or particulates from the gelatin solution."*** Why not? Appellant continues, ***"Ultrafiltration cannot remove these materials because it is solely a technique directed to removing dissolved components***

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***from a solution."*** The Examiner does not agree with this statement. Moreover, this contradicts Appellant's earlier assertion, i.e., ***"Page 13, lines 11-13 of the specification states that the separated solvent based layer (e.g. aqueous layer) contains particulates and/or oily type materials which are specific examples of the first component contaminants of interest in the present invention and referred to in the present claims. These materials end up in the solvent based layer such as by being dissolved therein."*** (Brief page 14, lines 10-14). If they are ***"dissolved,"*** as Appellant asserts, why can't ultrafiltration remove them???

### ***Appellant's Declaration***

The Schmidt Declaration was again reviewed, but not found to be persuasive. The Brief argues: ***"Paragraph 7 of the Schmidt Declaration indicates that the process disclosed in the '408 Patent does not perform on a commercially acceptable scale ..."*** (Brief page 22, lines 2-3). This is not found to be persuasive. The only mention of the components identified at Brief page 22, lines 5-7 in Appellant's disclosure is with respect to the "non-solvent based layer."

From Appellant's Specification Page 9, lines 11-14:

If recycled, the **non-aqueous layer** may be separated into oily components including, but not limited to, vitamins (for vitamin containing products (e.g. vitamin E)), mineral oil, garlic oil, fish oil, beta carotene, and vitamin E. (Emphasis added by Examiner)

Moreover, this argument is inconsistent with the express teachings of the Schmidt reference which teaches the recycling of the same waste products to obtain "a

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**recycled gelatin product with chemical and physical properties identical to virgin gelatin"** (Schmidt '408; col. 2, lines 48-51). In any event, the claims are not seen to be limited to a **"commercially acceptable scale"** - whatever that means. Thus, the instant claims are not commensurate in scope with the argument presented.

### **Licensing**

It is noted that Appellant is engaged in license negotiations for the present technology (Brief page 25, lines 19-21). As a public service, Appellant is reminded that large entity fees are due when a small entity enters into a license with a large entity.

### **Double Patenting**

A double patenting rejection was made on March 13, 2003. Appellant correctly argued that the language constituting prohibited new matter was not found in the claims of Patent No. 6,361,802, and therefore, the double patenting rejection was inappropriate. The Examiner withdrew the rejection. Should the Board of Patent Appeals and Interferences find that the language in question has basis in the originally filed disclosure, then the double patenting rejection will have to be revisited and a determination made as to whether the language in question would likewise, find basis in the disclosure of Patent No. 6,361,802, and if the claims would have been obvious over claims 1-20, of Patent No. 6,361,802. Again, since the starting materials in both instances are the same, one skilled in the art would readily appreciate that the resulting solutions would have the same make-up and behave in the same manner.

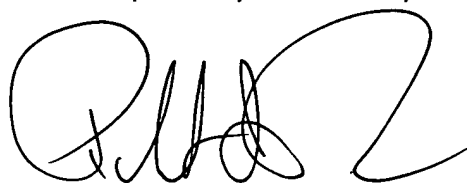
### **Appeal Conference**

An Appeal Conference was held on April 4, 2005. Supervisory Patent Examiners Patrick Ryan and Duane Smith, as well as Primary Examiner Popovics participated.

### Conclusion

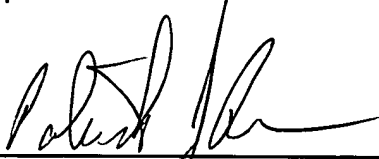
Appellant has not presented any valid argument or evidence that would tend to negate the rejections made by the Examiner. Appellant's statements regarding his own prior patent, presently applied as an art reference against the instant claims, contradict statements made in the prosecution of Patent Number 6,361,802 (Serial No. 09/609,217). Appellant's statements made during the prosecution of Patent Number 6,361,802 (Serial No. 09/609,217), regarding the operation of the applied reference (Schmidt - U.S. Patent No. 5,288,408), are consistent with the Examiner's interpretation of Schmidt '408. The Board of Patent Appeals and Interferences is respectfully urged to affirm all outstanding rejections.

Respectfully Submitted,



**Robert James Popovics**  
**Primary Examiner**  
**Art Unit 1724**

Appeal Conferees:



**Patrick J. Ryan**  
**Supervisory Patent Examiner**  
**Art Unit 1745**



**Duane Smith**  
**Supervisory Patent Examiner**  
**Art Unit 1724**

Enclosed: PTO-892